

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 0764MH-40404A

In re Application of:

CARL BROCK BRANDENBERG, ET AL.

Serial No.: **09/944,482**

Filed: **31 AUGUST 2001**

For: **LOCATION-AWARE WIRELESS
COMMUNICATION APPLIANCE AND
NETWORK**

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Examiner: **TRAN, MYLINH T.**

Art Unit: **2179**

Confirmation No.: **2351**

**JOINT STATEMENT OF APPLICANTS IN SUPPORT OF
RENEWED PETITION UNDER 37 C.F.R. § 1.137(b)**

We, the undersigned, Robert Kay, Carl Brock Brandenburg, and Kenneth Maxwell, are Applicants in the subject application. We are all over 18 years of age and are competent to make this Statement. This Joint Statement is being filed in support of the Renewed Petition to Revive, which is being filed concurrently in the subject application. We are responsible persons having first hand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

We declare and state that the following is a chronology of the facts and circumstances surrounding the abandonment and the filing of the Petition to Revive in the subject application:

1. The subject application was filed on 31 August 2001 on behalf of the Applicants by James E. Walton. **The Declarations executed by the Applicants name Mr. Melvin A. Hunn, Mr. Kenneth C. Hill, and Mr. James E. Walton as the attorneys of Record.**

2. At the time of filing, Mr. Walton was employed as an associate by the law firm of Hill & Hunn, LLP. The partner at Hill & Hunn, LLP who was responsible for the Applicants was Mr. Hunn.

3. On 4 October 2001, a Filing Receipt and a Notice to File Corrected Application Papers were mailed to James E. Walton at Hill & Hunn, LLP. The Filing Receipt and a Notice to File Corrected Application Papers were received on 12 October 2001.

4. On 16 October 2001, Mr. Walton promptly mailed the Filing Receipt and the Response to Notice to File Corrected Application Papers to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive.

5. On 15 November 2001, Mr. Walton promptly and timely filed a Response to Notice to File Corrected Application Papers. On 28 November 2001, Mr. Walton mailed a copy of the Response to Notice to File Corrected Application Papers to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive.

6. On 30 January 2002, an Updated Filing Receipt was mailed to James E. Walton at Hill & Hunn, LLP. The Updated Filing Receipt was received on 8 February 2002.

7. On 11 February 2002, Mr. Walton mailed the Updated Filing Receipt to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive.

8. **On 1 July 2003, Mr. Walton terminated his employment at Hill & Hunn, LLP and formed the Law Offices of James E. Walton, P.L.L.C. After 1 July 2003, Mr. Walton no longer had any right or authority to prosecute the subject application.**

9. **As of 1 July 2003, only Mr. Hunn and Mr. Hill were the attorneys of record in the subject application.**

10. Either Mr. Hunn or Mr. Hill should have promptly filed a Change of Address and a Revocation of Power of Attorney formally removing Mr. Walton as one of the Applicants' representatives; however, this was never done.

11. On 3 September 2004, **over three years from the filing date**, a first Office Action was mailed to James E. Walton at Hill & Hunn, LLP. The Office Action was received on 10 September 2004.

12. During 2004, Mr. Hunn became very ill with what was later determined to be leukemia. Mr. Hunn was unable to perform his duties at work from mid-2004 until July 2005, when he passed away from leukemia.

13. During 2004 and throughout Mr. Hunn's illness, Mr. Hill represented to Mr. Hunn's clients that Mr. Hill would be taking care of the prosecution of Mr. Hunn's clients' applications.

14. On 8 November 2004, the 3 September 2004 Office Action was sent to the Applicants, along with an unsigned Memorandum from Mr. Hunn to the Applicants. Had Mr. Hunn been well, this transmittal would have been in the form of a signed letter.

15. On 3 March 2005, a Response to the 3 September 2004 Office Action, along with a Three-Month Extension of Time, was filed by Mr. Hill.

16. On 27 April 2005, a Final Office Action was mailed, again, to James E. Walton at Hill & Hunn, LLP. The Final Office Action was received on 2 May 2005.

17. On 24 May 2005, the Final Office Action was mailed by Mr. Hill to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive.

18. In early July 2005, Mr. Hunn passed away. **After Mr. Hunn passed away, only Mr. Hill was the attorney of record in the subject application.**

19. On 27 September 2005, Mr. Hill filed a Request for Continued Examination, along with a Response to the 27 April 2005 Final Office Action and a Two-Month Extension of Time.

20. On 14 October 2005, the Request for Continued Examination and the Response were mailed by Mr. Hill to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive.

21. On 13 December 2005, an Office Action was mailed, again, to James E. Walton at Hill & Hunn, LLP. The Office Action was received on 19 December 2005.

22. On or about 23 December 2005, Mr. Hill moved his office from 201 Main Street, Suite 1440, Fort Worth, Texas 76102 to 6100 Southwest Boulevard, Suite 303, Fort Worth, Texas 76109. Mr. Hill must have delivered a Notice of Change of Address to the U.S. Postal Service, as some of the Office Actions mailed after 23 December 2005 were received by Mr. Hill.

23. On 6 January 2006, the Office Action was mailed by Mr. Hill to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive. **It is important to note that the Serial Number and the Attorney Docket Number were incorrectly listed on the subject line of Mr. Hill's letter, as this caused confusion among the Applicants.**

24. On 10 June 2006, Applicant Kenneth Maxwell sent an email to Mr. Hill urging Mr. Hill to have a draft of the Response to the 13 December 2005 Office Action prepared in time for review by the Applicants. A copy of Mr. Maxwell's email is attached to the Renewed Petition to Revive.

25. On 13 June 2006, Mr. Hill filed a Response to the 6 January 2006 Office Action, along with a Three-Month Extension of Time. The 13 June 2006 Response filed by Mr. Hill failed to include important revisions added by the Applicants.

26. On 16 June 2006, the Response was emailed by Mr. Hill to the Applicants. The Applicants' disappointment with Mr. Hill was conveyed to Mr. Hill in an email from Applicant Robert Kay to Mr. Hill on 16 June 2006. A copy of Mr. Kay's email is attached to the Renewed Petition to Revive.

27. On 19 June 2006, the Response was mailed by Mr. Hill to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive. **It is important to note that the Serial Number and the Attorney Docket Number were again incorrectly listed on the subject line of Mr. Hill's letter, as this caused confusion among the Applicants.**

28. On 21 September 2006, a Final Office Action was mailed, again, to James E. Walton at Hill & Hunn, LLP. The Final Office Action was received on 28 September 2006.

29. On 2 October 2006, the Final Office Action was mailed by Mr. Hill to the Applicants. A copy of the letter is attached to the Renewed Petition to Revive. **Again, it is important to note that the Serial Number and the Attorney Docket Number were incorrectly listed on the subject line of Mr. Hill's letter, as this caused confusion among the Applicants.**

30. The Applicants relied upon Mr. Hill to inform them of when Office Actions were issued, to remind them of when Responses were due, and to timely file all necessary Responses.

31. Mr. Hill made docket entries in his electronic docket system to respond to the Final Office Action by 21 December 2006, with a final response date of respond 21 March 2007. A copy of Mr. Hill's docket sheet dated 2 October 2006 is attached to the Renewed Petition to Revive. These docket entries were never changed or removed by Mr. Hill, which indicates that the Applicants never instructed Mr. Hill to allow the application to go abandoned.

32. After 2 October 2006, the Applicants copied Mr. Hill on numerous communications with respect to related applications and related lawsuits, but received no communications back from Mr. Hill.

33. The Applicants had filed several patent infringement lawsuits during this time frame on related patents, and had started to enter into settlement agreements with several of the defendants. Mr. Hill was aware of these lawsuits and was in communication with the Applicants' litigation counsel. This is evidence that the Applicants fully and clearly intended to keep the subject application alive and not to let it go abandoned.

34. As a result of the numerous communications that were sent by the Applicants to Mr. Hill, Mr. Hill was clearly aware that the Applicants did not intend to let

the subject application go abandoned, and that the Applicants were relying on Mr. Hill to timely respond to all Office Actions and take the necessary steps to keep the subject application alive.

35. Mr. Hill failed to file a Response to the 21 September 2006 Final Office Action, although Mr. Hill knew that the Applicants desired to have a response filed and to keep the application alive. **As a result of Mr. Hill failing to file a response to the Final Office Action, the subject application went abandoned on 22 December 2006.**

36. **In addition, Mr. Hill allowed several other of Applicants' patent applications to go abandoned during this same time frame.**

37. Neither Mr. Hill nor the Applicants ever received a copy of the Notice of Abandonment (Mr. Walton is now in possession of Mr. Hill's original file). The Notice of Abandonment was returned to the U.S. Patent and Trademark Office undelivered, as evidenced by the file wrapper. It is likely that the Notice of Change of Address that Mr. Hill delivered to the U.S. Postal Service expired after one year, resulting in the Notice of Abandonment being return undelivered. Mr. Hill should have renewed his Notice of Change of Address with the U.S. Postal Service.

38. The Applicants did not discover that the subject application had gone abandoned until on or about 10 June 2009, when the Applicants met with Mr. Hill for a status conference to review the status of the several applications that Mr. Hill was handling for the Applicants. **Thus, the Applicants first became aware that the application had become abandoned on or about 10 June 2009.**

39. On 11 June 2009, Mr. Hill prepared a Memorandum to the Applicants setting forth action items for several of the Applicants' patent applications, many of which had been abandoned by Mr. Hill without the knowledge of the Applicants. A copy of Mr. Hill's 11 June 2009 Memorandum is attached to the Renewed Petition to Revive.

40. As set forth at Item (3) of Mr. Hill's 11 June 2009 Memorandum, Mr. Hill represented to the Applicants that Mr. Hill would file a Petition to Revive the subject application and accept the allowed claims. Mr. Hill indicated the filing fee for the Petition

to Revive would be \$810.00. Attached hereto is a copy of Mr. Hill's handwritten notes indicating that he was going to file a Petition to Revive the subject application.

41. On or about 16 June 2009, the Applicants prepared a check to the USPTO in the amount of \$810.00 to cover the filing fee for the Petition to Revive the subject application, and delivered the check to Mr. Hill for filing with the USPTO. A copy of Mr. Kay's email to Mr. Hill, along with a copy of the check stub, is attached to the Renewed Petition to Revive.

42. **Mr. Hill never filed a Petition to Revive in the subject application, contrary to the Applicants' instructions and understanding.**

43. By February 2010, the Applicants were concerned that Mr. Hill had not filed the requisite Petition to Revive in the subject application and contacted Mr. Walton about taking over the prosecution of the subject application.

44. On or about 22 February 2010, Mr. Walton obtained the Applicants' files **(approximately one hundred files)** from Mr. Hill and promptly began investigating the status of the files and applications.

45. As a result of Mr. Walton's investigation, Mr. Walton was able to confirm that Mr. Hill had never filed a Petition to Revive in the subject application, even though he had represented to the Applicants that he would do so.

46. On 26 May 2010, Mr. Walton prepared and filed a Revocation of Power of Attorney and New Power of Attorney in the subject application.

47. On 7 June 2010, Mr. Walton filed the original Petition to Revive in the subject application.

48. The foregoing is evidence that Mr. Walton was not the counsel of record at the time the application went abandoned, and that Mr. Hill was the counsel of record.

49. Numerous phone calls and emails over several months have been sent to Mr. Hill, but Mr. Hill has not responded. As such, it has not been possible to obtain a statement from Mr. Hill with respect to the abandonment of the subject application.

Conclusions:

We submit that the foregoing facts and evidence support the following conclusions:

1. Mr. Hill was the sole attorney of record in the application at the time the application became abandoned.
2. The Applicants intended to respond to the Final Office Action mailed 21 September 2006, and instructed Mr. Hill to do so.
3. Mr. Hill failed to respond to the Final Office Action dated 21 September 2006.
4. Neither Mr. Hill nor the Applicants received the Notice of Abandonment.
5. The Applicants first became aware that the application was abandoned on or about 10 June 2009.
6. The Applicants paid for and thought that a Petition to Revive had been filed by Mr. Hill promptly after the discovery that the application had become abandoned.
7. Mr. Hill has not been cooperative with the Applicants since the application became abandoned.
8. The Applicants exercised due care and diligence throughout the timeframe before and after the application was abandoned, including through the time that the Petition to Revive was actually filed.

Therefore, pursuant to MPEP 711.03(c)(II), subsection D, we submit that:

(A) We first became aware of the abandonment of the application on or about 10 June 2009; and

(B) the foregoing statements of fact represent a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on our part.

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All statements made herein of our own knowledge are true and all statements made on information and belief are believed to be true; and further, these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Robert L. Kay
Robert Kay

9/29/10
Date

Carl Brock Brandenburg

Date

Kenneth Maxwell

Date